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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,411	07/07/2006	Seung-Kyoon Noh	3566-0113PUS1	2743

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EXAMINER
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MCCLELLAND, KIMBERLY KEIL

ART UNIT	PAPER NUMBER
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1791

NOTIFICATION DATE	DELIVERY MODE
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12/30/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/585,411	<b>Applicant(s)</b> NOH, SEUNG-KYOON	
	<b>Examiner</b> KIMBERLY K. MCCLELLAND	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 10-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>07/07/06</u> . | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 1-9 in the reply filed on 09/28/09 is acknowledged.
2. Claims 10-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 09/28/09.

***Claim Objections***

3. The claims are objected to because they include reference characters which are not enclosed within parentheses.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 5 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. The term “clamp shaft” in dependent claim 5 is unclear. It is unclear what structure is being recited. Based on the limited disclosure of the current specification, the term “clamp shaft” is interpreted as meaning “rotational shaft” as illustrated by element 91 in Figure 6.

7. The term “fork pipe” in dependent claim 9 is unclear. It is unclear what structural feature is being recited. Based on the limited disclosure of the current specification, the term “fork pipe” is being interpreted to mean “roller” as illustrated by element 122 in Figure 9.

8. An applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s). See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). Any special meaning assigned to a term “must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.” *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999)

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 3, 5, and 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,065,894 to Garland.

11. With respect to claim 1, Garland discloses a dispenser, including a tape cassette having a tape roll (1) with tapes inserted between two sheets; and a tape cassette driver (6) driving the tape cassette, wherein the tape cassette includes a first rotational shaft (28) rotatably supporting the tape roll, a second rotational shaft (24) designed to collect one of the two sheets by winding the same in a roll type, a third rotational shaft (25) designed to collect the other of the two sheets by winding the same in a roll type, and a tape ejection roller assembly (2/3) outwardly ejecting a tape from which the two sheets are removed, and the tape cassette driver is designed to drive the second and third rotational shafts (See Figures 1-2).

12. Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Consequently, the tape and two sheets are not further limiting to the currently claimed apparatus.

13. This rejection is based on the fact the apparatus structure taught above has the inherent capability of being used in the manner intended by the Applicant. Claims

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directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

14. As to claim 3, Garland discloses the second and third rotational shafts are simultaneously driven by a timing belt (38; See Figure 1).

15. As to claim 5, Garland discloses the first rotational shaft serves as a clamp shaft (28; See Figure 1).

16. As to claim 8, Garland discloses the ejection roller assembly includes a tape feeding roller (2/3), and the tapes are outwardly ejected by the feeding roller (See Figure 1).

17. As to claim 9, Garland discloses the tape roll (1) is fixed to a first fork pipe (29) having a through hole at the center, ends of the sheets are respectively fixed to second (4) and third fork pipes (5) each having a through hole at the center, and the first to third fork pipes are fixed into an external box (51) which is built to allow the first, second and third fork pipes to be respectively fixed to the first, second and third (28/24/25) rotational shafts through the respective through holes (See Figure 1).

18. Claims 1-2, 4-5, and 8-9 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,077,289 to Ross.

19. With respect to claim 1, Ross discloses a dispenser, including a tape cassette having a tape roll (120) with tapes inserted between two sheets; and a tape cassette driver (160/170) driving the tape cassette, wherein the tape cassette includes a first rotational shaft (122) rotatably supporting the tape roll, a second rotational shaft (142)

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designed to collect one of the two sheets by winding the same in a roll type, a third rotational shaft (152) designed to collect the other of the two sheets by winding the same in a roll type, and a tape ejection roller assembly (131) outwardly ejecting a tape from which the two sheets are removed, and the tape cassette driver is designed to drive the second and third rotational shafts (See Figure 4).

20. Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Consequently, the tape and two sheets are not further limiting to the currently claimed apparatus.

21. This rejection is based on the fact the apparatus structure taught above has the inherent capability of being used in the manner intended by the Applicant. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

22. As to claim 2, Ross discloses idle roller shafts (shafts of rollers 131) provided in the vicinity of the ejection roller assembly to simultaneously pass through the sheets and the tapes (See Figure 4).

23. As to claim 4, Ross discloses the second and third rotational shafts (142/152) are capable of having a rotational speed different from each other (see Figure 4).

24. This rejection is based on the fact the apparatus structure taught above has the inherent capability of being used in the manner intended by the Applicant. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

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25. As to claim 5, Ross discloses the first rotational shaft serves as a clamp shaft (122; See Figure 4).

26. As to claim 8, Ross discloses the ejection roller assembly includes a tape feeding roller (131), and the tapes are outwardly ejected by the feeding roller (see Figure 4).

27. As to claim 9, Ross discloses the tape roll (120) is fixed to a first fork pipe (121) having a through hole at the center, ends of the sheets are respectively fixed to second and third fork pipes (141/151) each having a through hole at the center, and the first to third fork pipes are fixed into an external box (110) which is built to allow the first, second and third fork pipes to be respectively fixed to the first, second and third rotational shafts through the respective through holes (See Figure 4).

### ***Claim Rejections - 35 USC § 103***

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,077,289 to Ross as applied to claims 1-2, 4-5, and 8-9 above, and further in view of U.S. Patent No. 5,694,629 to Stephenson, III et al.

30. With respect to claim 6, Ross discloses one of the second and third rotational shafts (142/152), which is capable of a rotational speed faster than the other. However, Ross does not specifically disclose torque limiter means.



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31. Stephenson et al. discloses a film winding shaft, including torque limiter means (36; See Figures 1 and 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include torque limiting means on both winding shafts of Ross as taught by Stephenson et al. The motivation would have been to prevent damage to the sheet (column 1, lines 5-10).

32. As to claim 7, Ross does not specifically disclose the torque limiter means are of resilient arms.

33. Stephenson et al. discloses a film winding shaft, including torque limiter means of resilient arms (36; See Figures 1 and 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include torque limiting means of resilient arms on both winding shafts of Ross as taught by Stephenson et al. The motivation would have been to prevent damage to the sheet (column 1, lines 5-10).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIMBERLY K. MCCLELLAND whose telephone number is (571)272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Thr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kimberly K McClelland/  
Examiner, Art Unit 1791

KKM

/Philip C Tucker/  
Supervisory Patent Examiner, Art Unit 1791